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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,414	02/11/2004	Jonathan Fanger	101896-0239	2408

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NUTTER MCCLENNEN & FISH LLP  
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EXAMINER
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STEWART, ALVIN J

ART UNIT	PAPER NUMBER
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3774

NOTIFICATION DATE	DELIVERY MODE
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12/12/2007

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docket@nutter.com

# Office Action Summary

Application No.

10/776,414

Applicant(s)

FANGER ET AL.

Examiner

Alvin J. Stewart

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2006.  
2a) ☒ This action is FINAL. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19, 21-24, 27-33, 35-40 and 65-74 is/are pending in the application.  
4a) Of the above claim(s) 5, 11, 27-33 is/are withdrawn from consideration.  
5) ☒ Claim(s) 75 and 76 is/are allowed.  
6) ☒ Claim(s) 1-4, 9, 10, 17-19, 35-40, 65, 73 and 74 is/are rejected.  
7) ☒ Claim(s) 6-8, 12-16, 21-24 and 66-72 is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 11 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10/12/04

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Arguments*

Applicant's arguments with respect to claims 1, 35, 65, 73 and 74 have been considered.

The Examiner is making another office action in order to clarify the interpretation of the word "communication".

The meaning of the word "communication" in the Merriam-Webster Dictionary is: ---a means of access or communication---. The examiner is interpreting the communication as follow: In Figure 2, elements 29 and 49 at connecting the pathways 30 and 31. Therefore, the two pathways (30 & 31) are in communication with each other, thanks to the two elements structures that are connecting the pathways.

The Applicant's representative has not given any arguments regarding the Double Patenting rejection.

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned

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with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2, 5-18, 32, 34-36 and 38-40 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17, 25, 27 and 28-32 of copending Application No. 10/664,575. Although the conflicting claims are not identical, they are not patentably distinct from each other because the structure claimed is essentially identical with minor substitutions of terminology such a bore for pathway and the minor preamble difference of intended use as being for a "spinal plate" in the copending application, the applicant is respectfully reminded that intended use, as set forth in the claims, carries no weight in the absence of any distinguishing structure.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

#### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 9, 10, 17-19, 35, and 65 are rejected under 35 U.S.C. 102(e) as being anticipated by Null et al US Pub./ 2004/0015174 A1.

Null et al discloses a guide device having at least one pair of thru bores comprising an elongated shaft (20) having a proximal end (14), a distal end (25), a guide member (12) coupled to the distal end of the shaft and including first and second pathways (30 & 31) at least partially in communication with one another (they are in communication with each other because they are touching each other) and the distal end of the elongate shaft being offset from the first and second pathways (see Fig. 1). Therefore, the three axes are offset from each other). At least one tab (35).

Regarding claims 9-10, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Claims 1, 35, 36-40, 65, 73 and 74 are rejected under 35 U.S.C. 102(e) as being anticipated by Foley US Pub. 2004/0092947 A1.

Foley discloses a guide device having at least one pair of thru bores comprising an elongated shaft (42) having a proximal end (46), a distal end (40), a guide member (25) coupled to the distal end of the shaft and including first and second pathways (66 & 26) at least partially in communication with one another (by element 41) and the distal end of the elongate shaft being offset from the first and second pathways (see Fig. 1). Therefore, the three axes are offset from each other). At least two tabs (68 & 28). Elements 68 and 28 have a C-shaped form.

Regarding claims 9-10, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

*Allowable Subject Matter*

Claims 6-8, 12-16, 21-24, 66-72 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 75 and 76 are allowed.

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin J. Stewart whose telephone number is 571-272-4760. The examiner can normally be reached on Monday-Friday 7:00AM-5:30PM(1 Friday B-week off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Alvin J Stewart

Application/Control Number: 10/776,414

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*A. Stewart*  
**ALVIN J. STEWART**  
**PRIMARY EXAMINER**

Primary Examiner  
Art Unit 3774

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December 4, 2007.